

**REMARKS**

Claims 1-28 are pending.

Claims 1-28 are rejected.

Claims 1 and 20 are amended to recite "on demand" content program, as to be consistent with the preamble of Claim 1. This amendment is also being made to define the technological field of the invention.

Claim 3 is amended to recite that "linking information" is used for obtaining content from a content provider.

No new matter was added in view of these amendments.

**I. U.S.C. 102(e) Rejection of Claims 1-9, 11-24, and 26-28**

The Examiner rejected Claims 1-9, 11-24, and 26-28 under 35 U.S.C. 102(e) as being anticipated by Dejaeger, (U.S. Patent 6,296,185). Applicants disagree with this ground on rejection.

Regarding the rejection to Claim 1, the Applicants note that the reference does not at all disclose the concept of having a content provider who would provider content to a user receiver. Respecting the Examiner's decision to interpret the claim language broadly, the Applicants have amended Claim 1 as to claim that said at least one content provider "transmits on-demand content to a user receiver by a network". That is, the content being claimed as provided by at least one content provider would be on-demand programming. The delivery of on-demand programming is neither disclosed nor suggested in the Dejaeger reference.

That is, the Dejaeger reference is a physical retail terminal system which one would find in a retail store such as Wal-Mart or Target where a user may use such a terminal to physically buy groceries (see Abstract of Dejaeger). Specifically, a user

uses a pre-scan area 12 to scan items such as groceries where are sensed via a scanner sensor (98, 100) (see Dejaeger, col. 6, lines 54-63). Applicants note that a grocery system that one would find at a Wal-Mart has nothing to do with the delivery of on-demand content which is provided by a content provider (as claimed in Claim 1) which would be provided to a user receiver.

The Examiner, in the rejection, argued that such recitation of “on-demand content” is not relevant because the delivery of such content was not in the claims as presented. As amended, a request and the authorization of on-demand content are claimed in Claim 1 and in Claim 20.

Moreover, the Examiner is incorrect about the recited “on-demand content” as being an adjective which merely describes the services or products that are sold by the provider. It is important to note that the field of the invention operates with “content providers” who provide “on demand content” which will be authorized to be delivered, in view of certain criteria. The use of such claim language effectively limits the field of the invention can be applied. Also, regardless of the amendments made to the claims, the Examiner is reminded that “during examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art. If so, the recitation serves to limit the claim.” See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). The delivery of on-demand programming is relevant, in view of this type of case law.

Hence, following the amendment made for Claim 1, reconsidering Dejaeger, the grocery check out system (of Dejaeger) does not disclose the element of “content corresponding to each of said selected one or more financial transactions is authorized to be transmitted to said user receiver by said at least content providers affected by said selected one or more financial transactions”. That is, on-demand programming will be delivered to a user receiver by a content provider when one or more financial transaction is authorized. The grocery check-out system of Dejaeger

neither discloses nor suggested this claimed step.

Claim 3 claims the element of “including linking information for obtaining additional content from a specific content provider”. This specific element of Claim 3 is neither disclosed nor suggested in Dejaeger. Dejaeger does teach the concept of displaying of displaying an advertisement related to a grocery that a person is buying at a store (Dejaeger, col. 59, lines 49-64) such as when a person buys beer from a store, one would see an advertisement for beer. This disclosure of Dejaeger has nothing to do with a claimed content provider (as in Claim 3) nor does such advertisement of Dejaeger provide “linking information” to a content provider. Applicants have amended Claim 9 to give more of a definition to linking information which “allows a user to access a specific content provider”.

The Examiner in the rejection rebuts the above statements by stating that Dejaeger teaches the “concept of displaying an advertisement relates to a grocery that a person is buying at a store”. Hence, the Examiner states that such claimed “linking” information is considered to be “information that links a the consumer and goods to a provider”.

Applicants notes that the Examiner probably meant Claim 3, not Claim 1, in the comments section. Regardless, it is to be understood that the Examiner is misapplying the definition of “linking information” as being some kind of reminder that tells a person the origination of a good or service in a grocery store. The term “linking information” in the technical field used by the Applicant would not make that much sense in this type of setting, as Dejaeger is in a grocery (physical setting) while the present invention is in a multimedia/enhanced content/content provider setting, where linking information is used to obtain additional information from a specified content provider.

Claim 20 is patentable (for the same reasons listed above for Claim 1) as the operation of delivering enhanced content programming of a television program (for a

user receiver) from a content provider is neither disclosed or suggested in Dejaeger. That is, the disclosures and teachings of Dejaeger do not disclose the existence of content providers or the delivery of enhanced content from such content providers which would be authorized in view of financial transaction.

The Examiner's recitation that claimed elements are non-descriptive functional matter for the claim is not correct, in that once again the field of the invention operates with set top boxes, content providers, on-demand content, and the like. This should be clear, in view of the substance of the claims and the specification; these technological concepts apply to the distribution of content in an electronic delivery environment such as the internet, cable company, satellite company, telecommunication company, and the like. To help further this point of the Examiner, the Applicants have included the recitation of on demand content in the body of the claim.

Moreover, even if the Examiner were correct about the various terms of the claims, as being non-functional descriptive material, which the Applicants content is not the case, when presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). This case provides a basis for determining whether a claim limitation is relevant or not. In the present application, and for the reasons given above, such claim limitations are relevant.

For the reasons given above, Applicants request that the Examiner remove the rejections to Claims 1-5, 7-9, 12-24, and 26-28 are patentable for the reasons listed above.

## **II. U.S.C. 103(a) Rejection of Claims 6 and 11**

The Examiner rejected Claims 6 and 11 under 35 U.S.C. 103(a) as being unpatentable over Dejaeger in view of the Examiner's official notice.

The operation of Claim 6 is not disclosed or suggested in Dejaeger. Specifically, Dejaeger does disclose the idea of having a single format in which to display a check out transaction such as using item price, item description, and the like (see Dejaeger, col. 6, lines 48-56). This operation however has nothing to do with determining the display capabilities of a set top box which operates as the user receiver. That is, Dejaeger also knows how information is going to be displayed without considering the "display capabilities" of the user receiver where the display capabilities affect which format is to be used, unlike what is claimed in Claim 6. That is, the disclosed system of Dejaeger does not perform the operation of Claim 6 nor is such an operation even suggested.

In response to the argument above, the Examiner states that "Dejaeger makes use of a display monitor, as part of the check out system" then states, "Examiner interprets that by displaying information to the consumer using the monitor, the provider has determined that monitor's display capabilities". The Examiner is wrong about this conclusion.

A content provider would have to know something about a display device in order to know about the display capabilities of a monitor. Although we claim a set top box, the Examiner assumes that if a device is capable of displaying a video signal, the content provider must have already determined the capabilities of the device. This is not correct. Typically, in the setting that the Examiner is referring to, a content provider would not have to know anything about a display device, rather the device will either be able to display the information from the content provider or not.

For example, consider a television set and a cable operator. If a user plugs a co-axial cable into a television set, the Examiner assumes that the cable operator will

automatically know about the display capabilities of the television set, if the television set displays a television signal. Obviously, this is not correct because for example, the television set may not have a QAM demodulator or only a NTSC tuner, so the television signal from the cable operator would not be displayed on the television. Likewise, if the television set were an HDTV television set, does the cable operator know under the Examiner's use of Dejaeger if the television is capable of using any one of a 16X9, 4X3, 720p, 1080i, 1080p, video signal. Probably not? At best, it is to be assumed from Dejaeger that the same format is used for a checkout counter, and hence the claimed operation of Claim 6 would not be performed, as there is no plurality of formats in the environment of Dejaeger.

The Examiner also states that the use of a display monitor versus a set top box would not modify the operation of the invention. This is incorrect because a display device and a set top box are different devices. A display device is primarily used as an output device versus a set top box which is used as an input and an output device, where the set top box is used for obtaining and receiving on-demand content.

Applicants' request that since the Examiner is taking official notice in the rejection that a set top box and a display device are functionally equivalent, that the Examiner provides some reference that discloses or teaches such a concept. The Examiner's recitation that the Applicant has not persuasively demonstrated the criticality of providing this arrangement versus the arrangement disclosed in Dejaeger because the Examiner has not properly established a prima facie case to rejection Claims 6 and 20 under 35 U.S.C. 103(a). Please provide a reference to use in conjunction with Dejaeger to support the official notice rejection, and/or consider the concept that the reference does not consider a plurality of formats and that a set top box and a display device are not equivalent devices.

For the reasons above, Applicants request that the Examiner remove the rejection to Claims 6 and 20.

### III. U.S.C. 103(a) Rejection of Claims 10 and 25

The Examiner rejected Claims 10 and 25 as being anticipated by 35 U.S.C. 103(a) as being unpatentable over Dejaeger in view of Fields (U.S. Patent 4,400,724). Applicants disagree with this ground of rejection.

Claim 10 claims “displayed summary information is displayed as a semi-transparent screen overlay”. Presumably, this would be a function of a user interface where the display summary transaction would be displayed semi-transparently within the context of displaying text on a screen (in front of a background). The Examiner in contrast acknowledges that Dejaeger does not disclose or suggest such a claimed element, but that when combined with Fields, such an element is taught.

Fields teaches a specific structure of using a video combiner 100 that displays a video signal in a full intensity of color while having a second video signal from overhead cameras be displayed as a white and black signal which will be reduced in intensity and appear “ghost-like on the screen as a semi-transparent overlay” (Fields, col. 11, lines 3-7).

Applicants request that the Examiner supply some type of rationale as why one would combine the check out grocery system of Dejaeger with the virtual reality system of Fields which utilizes overhead cameras to produce a semi-transparent overlay? That is, in order to produce the semi-transparent display of Fields with Dejaeger, as skilled artisan would have to utilize an external black and white camera as an input signal (from Fields) which is focused upon displayed summary information (from Dejaeger). That is, one of the ordinary skill in the art would not apply Fields with Dejaeger, as stated by the Examiner, as the outcome is complex would not disclose the operation of Claim 10. The same argument applies for Claim 25.

The rationale the Examiner supplies in the rejection is “that the semi-transparent screen display represents a well known display output that would be

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obvious to the disclosure of Dejaeger". Although this may be true, the Examiner has not explained why such a semi-transparent screen display would be combined with the concepts of Dejaeger, but for arguing that such a technique is well known. This is not the correct type of argument to apply. For example, does the Examiner believe that there is some type of reason why one would make such a combination? Such a rationale is required in terms of making a prima facie rejection under 35 U.S.C. 103(a). The strongest rationale for combining references is a recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent, that some advantage or expected beneficial result would have been produced by their combination. *In re Sernaker*, 702 F.2d 989, 994-95, 217 USPQ 1, 5-6 (Fed. Cir. 1983).

For the reasons given above, Applicants assert Claims 10 and 25 are patentable and such claims depend on allowable Claims 1 and 20, respectively. Applicants request that the Examiner remove the rejection to these claims.

Respectfully submitted,

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